

REMARKS

Claims 33-62 are now pending in the application. The amendments to the claims contained herein are of equivalent scope as originally filed and, thus, are not a narrowing amendment. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

The feature of selecting a class of headings for goods/services that appear at page 20 lines 28-30 of the specification as filed, and [0145] of the specification as re-published.

The feature of presenting goods and services as a predetermined set of words appear at page 20 lines 1,2 of the published international specification, and [0146] of the re-published specification.

The feature of effecting a selection by selecting a heading of goods/services in which case, the selection corresponds to all goods/services stored in the predetermined list of goods/services corresponding to the heading appears in the published specification at page 21 lines 4-16 of the international publication, and [0147] of the published US specification.

The feature of the ability to modify the list of goods/services by additional deletion of words and/or entering of new text appears at page 23 lines 1-19 of the international application as published, and [0152] of the US publication, and generally with reference to figures 10-15 of the application as filed.

35 USC §102

US 6,629,092 B (Berke)

In contrast to the present disclosure, Berke discloses a search engine for finding trade marks on a network, such as the internet, and for identifying traders who are sources of those trade marks or suppliers of goods or services under those trade

marks.

As set out previously, the present application aims to overcome the problem of data input of long and complex lists of goods and services in an on-line environment which is subject to line interruptions, crashes and user time constraints.

As a practical matter, the inventors have found that a practical constraint in adoption of on-line filing technology for trade marks is the sheer difficulty of filling in the on-line forms, and the fact that this process has to compete with the easier option of phoning up a trade mark attorney, or filling in a paper form, in terms of difficulty and time expended at the client computer end. At the time of devising the invention, technical improvements to computer systems, were necessary to deliver an efficiently useable client interface and in general at the time of the invention, practically useable systems were unavailable.

With respect to MPEP 2106l**vb**1(b) *"None functional descriptive material"*, the applicant respectively submits that the amended claims filed herewith incorporate a predetermined list of words, and the interactive selection of those words, plus the ability to add new words of goods/services (which are not necessarily within the predetermined presented list) hides a functional interrelationship in the way in which the processes of the claimed invention are performed, since there is inter-activity between the presented list of goods and services, in the form of headings and/or individual words, and the user, in a non-obvious manner.

It is respectfully submitted that the Examiner's observations fail to take in account that in presenting a computer-human user interface, the functionality of that interface must be such that in practice it is useable by a human in the limits of human capabilities. For example, if one designs an automobile with a de-pressable clutch lever, then even if clutch levers are obvious from other applications, if the clutch lever is not designed to be operable by a human, for example because the spring is so resilient that a normal human muscle could never press the lever, then the fact that

the lever has been optimised for human usage would render the design of the clutch lever none-obvious. The situation is somewhat analogous to the situation described by the present amended claims, which are also none-obvious.

In particular, provision of a set of class headings for goods and services, and presenting the information as a predetermined set of words, firstly end embeds knowledge into the system (i.e. the knowledge of the correctly allowable goods and services according to the official classification system, either a local national classification system or an international classification system), and additionally presents the human user with knowledge of which goods and services are available for a registered trade mark application, plus the option of selecting all or none of those goods and services in an easy to use format.

Similarly, the ability to interactively amend a predetermined list of goods and services, and to select/de-select individual class headings in total, not only presents the human user with information and knowledge of what is available for a trade mark registration, in a form effectively served up by a knowledge base, but also allows the human user to add and modify the information in a very time effective manner.

These features enable an otherwise basically un-useable on-line system in to a system, which is useable within the confines of human patience and attention span.

The applicant respectfully submits that technical progress in the art has been made, and that ergonomic factors should be taken into account in determining the inventive step of information systems and methods.

Additionally, the applicant respectfully submits that the Examiner's observations include a certain element of ex post facto analysis in the combination of prior art elements. At the time of the inventors, the applicant had no motivation for combining the teaching of Berke with the teaching from Onelook.com computer dictionary, of pull-down menus and scrollable lists.

The applicant submits that the invention as claimed is patentable over the prior art citations.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

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Respectfully submitted,

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